

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

REMARKS:

Claims 1-5, 7-11, 14 and 17-22 are all the claims pending in the present application. Claims 3-5 are withdrawn from consideration and claims 1, 2, 7-11, 14 and 17-22 stand finally rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and remarks that follow.

CLAIM REJECTIONS.

35 U.S.C. §102

Claims 1, 7, 17 and 21 are rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent 10226279A to Suzuki et al. (hereafter "Suzuki"). Applicant respectfully traverses this rejection claims, for the following reasons.

LEGAL STANDARD.

It is well established that a claim is only anticipated under 35 U.S.C. § 102 if each and every feature as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

ARGUMENT.

In the instant case, the Office Action alleges Suzuki discloses all of the features of Applicant's independent claim 1 which recites:

A personal article holder comprising:

a clamping body having a clamping position and an open position and comprising an upper arm; a lower arm pivotally connected at one end thereof, to a corresponding end of the upper arm such that personal articles may be retained between the upper and lower arm, said clamping body also having a cavity formed therein;

attachment means connected to the clamping body for attaching the clamping body to a desired surface; and

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

a tool operative to be removably inserted into said cavity.

Suzuki discloses a combination eyeglass holder and card holder. (See Figs. 1-6 and par. [0023]). The Office Action apparently alleges that element 20 of Suzuki is analogous to a *tool operative to be removably inserted into* [the device] *cavity* as claimed in Applicant's claim 1 or Suzuki card holder is analogous to the "*tool securing means*" as alleged recited in Applicant's independent claim. 17. Respectfully, element 20 is not a tool, it is a card such as a business card. (Suzuki par. 0004; 0005; 0006; 0014, etc.). Applicant respectfully submits that the Office Action is interpreting Applicant's claims with undue breath and in a manner which is inconsistent with the disclosure of Applicant's specification.

The Office is required to interpret claims using the broadest *reasonable* interpretation which must be consistent with the interpretation that those skilled in the art would give. *In re Cortright*, 165 F.3d 1353,1359 (Fed. Cir. 1999). Such interpretation must also be consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). Because Suzuki fails to disclose *a tool operative to be inserted into the cavity* or *tool securing means* it cannot anticipate either of Applicant's independent claims 1 and 17 (or the claims which depend therefrom). In view of the foregoing, reconsideration and withdrawal of this 102 rejection are respectfully requested.

35 U.S.C. § 103

Claims 1-2 and 7-11, 14 and 17-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over one of the following combinations: (I) previously cited U.S. Patent 6,728,995 to Ainley et al. (hereinafter "Ainley") in view of Chang and/or in further view of additional secondary references including U.S. 6,178,085 to Lueng; (II) newly cited U.S. Patent 6,681,452 to Holland in view of newly cited U.S. Patent 6,101,689 to Jo and/or this new combination in view of one or more of Ainley, Leung and/or Suzuki; or (III) Suzuki in view of Ainley. Applicant respectfully traverses all of these rejections for the following reasons.

LEGAL STANDARD

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682.

ARGUMENT

(I) THERE IS NO OBJECTIVE REASON TO COMBINE/MODIFY AINLEY AND CHANG

In first of the 103 rejections based on Ainley as a primary reference, the Office Action relies on Ainley to disclose the majority of Applicant's independent claim limitations (e.g., claims 1, 9 and 17) with the exception of *a tool operative to be removeably inserted into a cavity* (claims 1 and 9), or *tool securing means disposed on a surface of said clamping means* (claim 17).

The Office Action then relies solely on Chang to make up for this notable deficiency alleging "[i]t would have been obvious to a person having ordinary skill in the art... to configure the recess of Ainley et al. in such a manner to be able to removably insert Chang's calculator in order to provide a convenient mounting surface for the calculator." Applicant respectfully disagrees and submits that there is no proper motivation for combining/modifying Ainley with Chang as suggested as suggested in the Office Action and thus all rejections based thereon are improper and should be withdrawn on this basis alone. The Office Action alleges it would be obvious for the skilled artisan to modify Ainley with the calculator of Chang "in order to provide

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

a convenient mounting surface for the calculator.” (8/17/06 Office Action pg. 8 and 2/7/07 Final Office Action pg. 3) Applicant continues to believe that this alleged motivation to combine references is fundamentally flawed. First, since Chang already discloses “a convenient mounting surface for the calculator” for the motivation suggested in the Office Action is entirely lacking any objective reason whatsoever as to why the skilled artisan would bother to modify the Spectacles Caddy 10 disclosed by Ainley with the clipboard including calculator disclosed by Chang.

It is apparent to the skilled artisan that a calculator could be useful in combination with a clip board. However, because the Office Action has not set forth any objective reasoning at all why the skilled artisan would even want a calculator to be included with the spectacles caddy 10 disclosed by Ainley, the Office Action has failed to even sufficiently alleged a case of *prima facie* obviousness. Thus the rejection of Applicant's claims based on the combination of Ainley and Chang is believed to be insufficient on its face.

Additionally, Applicant respectfully submits there is in fact no proper motivation why the skilled artisan would combine/modify Ainley with Chang. Ainley indisputably discloses a caddy designed for holding various types of spectacles. (Col. 1, ll. 1-5; 19-22; 36-37, etc.). By way of contrast, Chang discloses a clip board for holding paper. Since neither cited reference discloses or suggests that the embodiments/principles of their respective inventions could even be applied to other types of goods, and in fact there is no particular reason the skilled artisan would consider combining these references, there is no motivation to support combining/modifying in the manner suggested by the Office Action.

Because the proposed motivation for combining/modifying Ainley and Chang is not present in either of the cited references, and because no objective reasoning exists for combining these references (or even has one been alleged), Applicant submits that *prima facie* obviousness has not been established. The remaining secondary reference (leung) is not addressed since deficiencies of the Ainley and Chang combination render these rejections moot. Because there is

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

no proper motivation to combine Ainley and Chang, the rejections based on these references are improper and should be withdrawn.

THE COMBINATIONS BASED ON AINLEY AND CHANG FAIL TO TEACH OR SUGGEST APPLICANT'S CLAIM LIMITATIONS.

Lastly, the Office Action alleges that Ainley discloses a "cavity" formed in the clamping body which could be configured or modified to hold the calculator of Chang (8/17/06 Office Action pg. 7; 2/7/07 Final Office Action pg.). The 2/7/02 Final Office Action describes it as an "un-numbered recess in the top middle face of 3..." Because it is not numbered or referenced in the cited patent, Applicant can only assume the slight circular recess shown in the figures of Ainley and referenced by the Office Action does not serve any utilitarian purpose and therefore is merely an ornamental feature without any purpose. Thus this alleged "cavity" disclosed by Ainley, even if combined with the calculator of Chang, is NOT a cavity into which a tool (i.e., Chang's calculator) could be insertably removed, nor can it be considered *a tool securing means* as claimed in Applicant's independent claims. In fact, by the Office Action's own statement, the "cavity" of Ainley would still have to be modified, if even possible, to receive Chang's calculator. While the Chang clipboard may include such a cavity, Chang's clip omits several other elements expressly claimed by Applicant and thus even when Ainley is modified with Chang as proposed in the Office Action, Applicant's claim limitations are not disclosed or suggested.

For all the foregoing reasons, Applicant respectfully submits all the pending claims are patentable over the combinations based on Ainley and Chang and requests reconsideration and withdrawal of all these §103.

II. APPLICANT'S CLAIMS ARE PATENTABLE OVER THE COMBINATIONS BASED ON HOLLAND AND JO.

The Office Action cites asserts new 103 rejections based on the combination of Holland and Jo. The Office Action alleges Holland discloses the limitations of the rejected claims with the exception of cushion members disposed in the clamp. To make up for this deficiency, the

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

Office Action relies on Jo alleging "it would have been obvious...to make the holder of Holland with the cushions and attachment clip of Jo in order to securely grip the item being held without damaging it, as well as to attach the object holder to the clothing of a user.

In response, Applicant respectfully submits that there is no objective reason to combine Holland and Jo as proposed. Holland, similar to previously cited Chang, appears directed primarily to use with a clip board (See Fig. 8) and is used for holding paper and the like. Applicant respectfully submits that first, there is no reason to suspect that gripping an item using the clip shown by Holland (Fig. 4) would damage an item being held (i.e., paper). Second, Holland already discloses a means for potential hanging clamping apparatus 10 (via base member 12) using an aperture 29 and corresponding fastener or an adhesive or magnet (col. 3, ll. 38-49).

Respectfully, the proposed combination of these references, as with those previously proposed, is transparently derived in the piecemeal attempt to reconstruct Applicant's claims using the impermissible hindsight of Applicant's disclosure as a guide. As is well established from *Mills* (cited above) simply because a reference can be modified to meet the limitations of an Applicant's invention does not render the invention obvious unless there is some objective reason to do so. Applicant respectfully submits that since there is no objective reason to include the cushion members or attachment clip of Jo in the clamping apparatus with removably assembly of Holland (and certainly not placed in the specific manner claimed by Applicant), *prima facie* obviousness has not been established. For this reason alone, all 103 rejections based on the proposed combination of Holland and Jo is believed to be improper and should be withdrawn.

Even assuming it would be proper to modify Holland with the teachings of Jo (*arguendo*), these references taken alone or in combination, fail to teach or suggest the limitations present in Applicant's independent claims 1 or 9 or the claims which depend

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 10/712,792

therefrom. For example, claim 1 recites *a lower arm pivotally connected at one end thereof, to a corresponding end of the upper arm*. By contrast, Holland, which is cited as disclosing an analogous clamping body appears to disclose a pivot mechanism (e.g., hinges 18) which are connected in a middle area (see Fig. 4) as opposed on corresponding ends as recited by Applicant. The Office Action alleges that these claimed "ends" are analogous to the bottom surface of the upper arm and top surface of the bottom arm. However once again, the Office appears to be interpreting Applicant's claims with undue breath. The skilled artisan would recognize that the opposing surfaces of the Holland's clamp 10 are not "ends" pivotally connected.

Because Holland fails to teach or suggest at least the claimed upper and lower arm members pivotally connected on corresponding ends, Holland cannot disclose the clamping body claimed by Applicant in claim 1 or related limitations in claim 9 (or the claims which depend therefrom) and as alleged in the 2/7/07 Office Action. For all the foregoing reasons, Applicant respectfully requests the Examiner to reconsider and withdraw all the 103 rejections based on the combination of Holland and Jo.

III. APPLICANT'S CLAIMS ARE PATENTABLE OVER THE COMBINATION OF SUZUKI AND AINLEY.

The Office Action alleges that JP 10226279 discloses all the limitations of claims 19 and 20 with the exception of clamping means comprising an upper and lower arm formed of an injection molded plastic. The Office Action relies on Ainley to make up for this deficiency. Applicant respectfully submits that even assuming it were proper to combine these references as suggested, Suzuki and Ainley, taken alone or in combination, fail to teach or suggest the limitations recited in Applicant's claims 19 and 20.

As discussed previously with respect to the rejection under 35 U.S.C. § 102, Suzuki discloses a dual holder for 1 for holding cards and glasses. There is no tool or tool securing

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 10/712,792

means disclosed or suggested by Suzuki as implied by the Final Office Action dated 2/7/07. Accordingly, Suzuki fails to disclose or suggest the limitations present in claims 19 and 20 by virtue of their dependency on independent claims 1 or 17:

- a tool operative to be removably inserted into said cavity (as recited in claim 1 from which claim 19 depends)


-tool securing means disposed on a surface of said clamping means for securing a provided tool to said clamping means (as recited in claim 17 from which claim 22 depends)

Because Suzuki and Ainley, taken alone or in combination, fail to teach or suggest these features, *prima facie* obviousness has not been established with respect to these claims. For all the foregoing reasons, Applicant respectfully submits the 102 and 103 rejections of record should be withdrawn and hereby requests such action.

CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


Stuart A. Whittington
Registration No. 45,215
(480) 203-3235

7037 E. Monte Circle
Mesa AZ. 85209

Date: May 7, 2007